

## REMARKS

Applicant acknowledges the renumbering of the claims. Claims 11-16 remain.

The rejection of claims 11-16 under 35 USC 103(a) as being unpatentable over Anguera '191 in view of either Larson or Anguera '395, and Lewis is respectfully traversed.

The application of 35 USC §103 to the issue of patentability has been considered by the Supreme Court of the United States in *Graham v. John Deere* 148 USPQ 459 (S. Ct. 1966). The Supreme Court held that 35 USC §103 requires a three-pronged inquiry. It is necessary to:

- (i) determine the knowledge disclosed in the prior art;
- (ii) determine the differences between the teaching of the prior art and the claims at issue; and
- (iii) resolve the differences between the teaching of the prior art and the claims in question on the level of the ordinary skill in the art field.

## COMPARISON OF ANGUERA '191 AND INVENTION

A. Anguera '191 combines green wood strips of varying length disposed in an upright position in a row with other green strips, thus describing the wood grain of each strip being aligned in the same direction for each strip (plank).

Whereas:

Claim 11, 12 and 13 claims, "positioning a plurality of wooden boards in side to side abutment, each of said wooden boards including two sides and a lengthwise direction, each of said sides being flat and having a height and said height being the smallest dimension of said wooden boards"; and

Claim 14, 15 and 16 claims , "cutting said plank longitudinally into a plurality of wooden

plank sections; positioning said plurality of wooden plank sections in side to side parallel abutment with the wood grains of said plurality of wooden plank sections having alternating directions".

B. Anguera '191 clamps the boards.

Whereas applicant (all claims) concurrently compresses said plurality of wooden boards vertically and transversely before revolvingly embedding at least three spaced apart helical pins.

C. Anguera '191 drills a bore, moves the work piece and inserts a pin into a previously drilled hole.

Whereas applicant (all claims) claims "positioning a drill at a lateral outside edge of said plurality of wooden boards and a pin press at an opposite outside edge of said plurality of wooden boards:

    said drill having a drilling axis;

    said pin press having a pin press axis;

    said drilling axis and said pin press axis substantially aligned;

    drilling holes transversely through said plurality of wooden boards" and

    "revolvingly embedding said at least three spaced apart pins transversely through said plurality of wooden boards by forcing said helical pins through said holes, normal to said sides of said plurality of wooden boards, and normal to said lengthwise direction of said plurality of wooden boards" and further

    "said helical pins having an outer thread diameter and further having a root thread diameter, said drilled hole having a hole diameter; and said hole diameter greater than said thread root diameter and less than said outer thread diameter"

D. Both Anguera '191 and the applicant use pins with a square cross section and spiral threads.

Thus out of the first 4 compared elements, only one is the same, the other steps are drastically different. Note that the compression recited in the present claims is more than the result of mere clamping. in the present specification on page 12, lines 1-3, it is stated "cylinder 128 engages and compresses the boards 20. Therefore, in addition to providing the desired compression.....maintains the relative position of the boards 20 during drilling..." and at page 13 lines 2-4, " With the boards 20 no longer compressed, the pins so imbedded within the boards 20 experience a tensioning due to the boards 20 returning to their noncompressed state."

E. Thus, the limitation in the claims,"whereby said drilling step and said forcing step are sequentially performed while said plurality of wooden boards are laterally and vertically compressed and the helical threads of said plurality of helical pins become anchored within each of said wooden boards thereby fixing and maintaining said wooden boards in relative position", describes method of producing a product which is not contemplated by the prior art nor producible by following Anguera '191 as recognized by the examiner.

The examiner urges that Larsen and Lewis or Anguera '395 and Lewis in combination with Anguera '191 cure the defects of Anguera '191 and thereby make the present invention as claimed obvious.

LEWIS

Lewis could be urged to suggest the currently boring and pin insertion, which would not cure the deficiencies discussed in A, B, or F above.

LARSEN AND LEWIS

Larsen discloses a scaffolding with two adjacent planks having a pin extending there through the plank. According to translation, "the surface elements comprise multiple planks arranged side by side and penetrated and held together by a transverse connecting iron at each end of the element" (page 2, third paragraph). No information is provided on the process of attaching the elements together. However, since the walkway is to be "assembled easily and quickly", the pins are loosely fitted into the boreholes, so they can be removed and the system assembled elsewhere. This disclosure has no suggestion to any aspect of the present invention and is of only interest as "state of the art". It does not cure in any manner the defects of the elements A, B, C, or F discussed above and adds nothing to Lewis.

#### ANGUERA '395 AND LEWIS

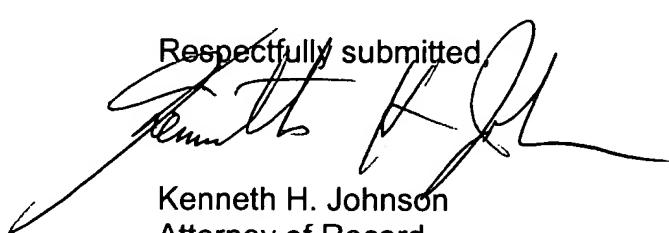
Anguera '395 discloses a very specific metal key that is to be driven into boreholes to thereby join adjacent boards together. This disclosure has little to add to the Anguera '191 disclosure other than one might substitute the specific key for the pins disclosed by Anguera '191, which of course does not cure any of the deficiencies noted above and adds nothing to Lewis.

There is no *per se* rule of obviousness that eliminates the need for fact-specific analysis of claims and the prior art and that the use of such a rule must stop. See *In re Ochiai*, 37 USPQ2d 1127, 1132 (Fed. Cir. 1996). The examiner is not applying the prior art to the claims because there is no disclosure of the specific limitations, but rather using silence as evidence. The examiner's bare statement that steps are "obvious mechanical expedients" is completely unsupported by any evidence and therefore has no weight. Silence in a reference is not a proper substitute for an adequate disclosure of facts. *In re*

*Burt*, 148 USPQ 548 (CCPA 1966). The examiner has failed to make out a *prima facie* case of obviousness because he has used a legal conclusion as evidence. Inventions are obvious over references and the examiner has not cited any reference to support his legal conclusion of "obvious mechanical expedients." (See *In re Bezombes*, 164 USPQ 387, 391 (CCPA 1970).

Rejections based on §103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner has the initial duty of supplying the factual basis for the rejection. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Even if the teachings of four references can be combined, there is no factual basis from which to conclude that the process resulting from the combined teachings would include the combination of elements of appellant's invention.

Respectfully submitted,



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